REMARKS

Status of Claims and Summary of Interviews

Claims 1 – 5, 7 – 9, 11 – 15, 17, and 18 are pending in this application. Claims 1 and 11 - 15 are herewith amended. Claim 9 is herewith cancelled. No new matter is presented by the amendments. Accordingly, Applicant respectfully requests entry thereof, and reconsideration of claims 1 – 5, 7, 8, 11 – 15, 17, and 18 in light of the above amendments and the following remarks.

Support for the amendments is found throughout the specification, drawings, and original claims of the present application and these prior disclosures. The present application claims the priority of, and incorporates by reference, its provisional application No. 60/199,834, (filed Apr. 26, 2000) as well as its parent U.S. Patent. No. 7,127,415 B1 (filed Nov. 16, 1999) (issued Oct. 24, 2006) (for convenience, copies of both are attached to this Supplemental Amendment as Exhibits A and B, respectively.) The presently amended claims are properly read in light of the combination of the present specification and the prior disclosures, incorporated by reference.

Applicant sincerely thanks Examiner Garg for his time and consideration in the telephonic interview on April 16, 2009 and subsequent telephonic discussions on April 22 & 23, 2009. In the April 16th interview, the Examiner suggested that Applicant amend the claims to more clearly recite the steps performed by the claimed special purpose computer. For example, the Examiner suggested that Applicant amend the claims to specifically provide that a special purpose computer performs the step of dynamically generating a product identifier. In addition, the Examiner suggested that in light of the prior art, the claims be amended to provide that the product identifier is further based on price. In a subsequent follow up phone call on April 22, 2009, the Examiner suggested that Applicant provide additional support from the disclosure

showing that a special purpose computer separates the product into an item, process, and artwork parameters and that the product identifier is based on price. In a second follow up phone call on April 23, 2009, Examiner further requested that Applicant provide additional support showing that a special purpose computer performs the linking of one or more item parameters, said one or more process parameters and said one or more artwork parameters. In addition, Examiner requested that Applicant address how the claimed product identifier is not taught by the "item classification code" discussion of U.S. Patent No. 5,109,337 (Ferriter et. al., issued Apr. 28, 1992) (*see* col. 5 ll. 45-65). The following supplemental amendments and remarks address the above suggestions pursuant to M.P.E.P 714.03(a)(2).

Claim Rejections – Rejection under 35 U.S.C. § 101

Claims 1 – 5, 7, 8, 11 – 15, 17, and 18 have been rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. This rejection is respectfully traversed. The rejections against the pending claims under consideration should be withdrawn for at least the following additional reasons set forth below.

The Examiner rejects the claims for failing to meet the standard machine-or-transformation test under *In re Bilski*. More particularly, the Examiner states that the claims are not tied to a special purpose computer, the "specific machine" under the *Bilski* test. However, Claims 1 and 11 have been amended to, *inter alia*, recite a method and system tied to a special purpose computer. In particular, Claims 1 and 11 recite storing product parameter data and a pricing algorithm on a data storage device such that the data storage device is accessible to the user by a user interface device on a network. *See* U.S. Pat. Pub. No. 20001/0047312 at Paragraph [0032] ("user may access the method and system of the present invention by logging into the system.") The product parameter data is pulled from the data storage device and representations

of the product parameter data are presented to a user through a graphical user interface (GUI) *Id.* ("Items and processes may then be searched and matched based on materials or other specifications and stored in a data base."). The user can then designate the features of a branded product by selecting product parameter data represented by the GUI. *Id.* at Para. [0035] ("At step 212, a user may create an item definition page by using an item template for the selected item category."); *Id.* at Para. [0038] ("[C]olors may be identified and/or selected from a list of available colors/patterns [and] material . . . may be identified and/or selected from a list of available materials"); *see also* Fig. 4 (illustrating the product selection step 212 and the dropdown menus and checkboxes displayed to the user over the GUI). The user can later retrieve, access, and edit previous projects by utilizing the dropdown menu displayed over the GUI. *Id.* at Para. [0040]; *see also* Fig 5 (depicting said menu screen with dropdown menus). The invention also allows a user to upload a digital image to be incorporated into the desired product, which is done using the special-purpose computer. *Id.* at Para. [0050]; *see also* Fig 11. The user is guided through the product selection process by the product parameter identifying and pricing computer through the graphical interface as it displays subsequent screens with dropdown menus giving additional parameters to select from. (*Id.* at Para. [0041]; Figs 6a & 6b); *Id.* at Para. [0044] ("Selecting a process category takes the user to an associated process template page for that category.").

The product parameter identifying and pricing computer then separates the request into at least an item, a process, and an artwork. When the user creates a request for a branded product, the product pricing and identifying computer separates the request into at least an item, process, or artwork parameters in order to access information from the data storage device that matches the product request. *Id.* at Para. [0033] ("Items and processes may then be searched and matched

based on materials or other specifications and stored in a database.") *see also* Fig 1 (depicting access of database 124).

Similarly, the product parameter identifying and pricing computer identifies one or more item parameters, one or more process parameters, and one or more artwork parameters. When the user creates a request for a branded product, the parameters are identified by the computer in order to assign a price via the pricing algorithm. *See Id.* at Para. [0033] ("[T]he pricing may be based on the item and process production specifications."); *Id.* at Para [0039] (describing how pricing information is identified).

The product parameter identifying and pricing computer then links said one or more item parameters, one or more process parameters, and one or more artwork parameters together. One skilled in the art could only read the Applicant's disclosure as teaching that the linking step is performed by the computer. Claim limitations can be supported by the specification, through express, implicit, or inherent disclosure. *In re Walter*, 292 F.2d 547, 48 CCPA 1094 (CCPA 1961). Applicant's disclosure states that the present invention embodies an end-to-end automated computer based method for managing the cataloguing, production, and distribution of promotional goods. *See* U.S. Patent. No. 7,127,415 B1 (filed Nov. 16, 1999) (issued Oct.,24, 2006) at col. 2 ll. 15-18, emphasis added ("It is another object of the present invention to provide vendor partners with *an e-commerce end-to-end business solution* to manage the cataloguing, production and distribution process."); Id. at col. 2, ll. 8-10 ("It is another object of the present invention to provide customers with a fast, cost efficient and simplified e-commerce solution to promote a brand."); Id. at col. 2 ll. 27-33, emphasis added ("The present invention provides an *all-encompassing exchange* that offers scaling opportunities and economies not available in the traditional business model. An online industry standard pipeline for data and order flow manages

the production and distribution process *from beginning to end.*"); Id. at col. 3 ll. 16-18 ("The present invention provides customers with an easy, efficient method of purchasing branded promotional products online."); Id. at col. 3 ll. 30-34 , emphasis added ("The present invention provides resellers the opportunity to leverage their sales efforts by streamlining the process of sourcing and pricing products and *automating* tedious administrative tasks."); *see also* Provisional Patent Application No. 60/199,834, (filed on Apr. 26, 2000) at Fig. 16 (showing overall data process flow for embodiment of present invention.); *see also* U.S. Pat. Pub. No. 20001/0047312 at Para [0015] ("The present invention enables manufacturers and distributors to maintain and control the product prices displayed on their web sites as well as the prices seen by individual customers.") Moreover, as discussed above, the present invention is embodies an end-to-end e-commerce solution performed by a special purpose computer. To the extent not explicitly disclosed in the specifications, the necessary and only reasonable construction to be given the disclosure by one skilled in the art is that the special purpose computer links the item, process and artwork parameters. The invention's computer-based method begins with a user logging into the system. *Id.* at Paragraph [0032] ("user may access the method and system of the present invention by logging into the system.") The product parameter data is pulled from the data storage device and representations of the product parameter data are presented to a user through a graphical user interface (GUI) *Id.* ("Items and processes may then be searched and matched based on materials or other specifications and stored in a data base."). The user can then designate the features of a branded product by selecting product parameter data represented by the GUI. Guiding the user over a GUI, the special purpose performs the steps of identifying and separating the item, process, and artwork parameters. Thereafter, the special purpose computer uses a pricing algorithm to assign a price and to dynamically generate a unique product

identifier. *Id.* at Para. [0038] (Describing pricing matrices applied to selected product); *Id.* at Para. [0047] (Describing how the "pricing matrices may vary according to the type of process and specifications made by the administrator.") *Id.* at Para. [0051] (discussing applying a CG number to the product); Figs 12a & 12b (illustrating product process edit page wherein a CG number has been generated for the product and displayed over the GUI). Accordingly, one skilled in the art could only view Applicant's disclosure as teaching that the special purpose computer performs the step of linking the item, process, and artwork parameters as claimed.

Pricing the product is also tied to a special purpose computer. After designating the desired product parameters as described above, a unique request is created and is transmitted back to the product parameter identifying and pricing computer over the network. The product parameter identifying and pricing computer then applies the appropriate pricing algorithm from the data storage device, based on the pricing matrices input by the administrator. *Id.* at Para. [0038] (Describing pricing matrices applied to selected product); *Id.* at Para. [0047] (Describing how the "pricing matrices may vary according to the type of process and specifications made by the administrator.") The product parameter identifying and pricing computer then applies the pricing algorithm to derive the price of the requested item. This price is then transmitted back over the network to be viewed by the user over the GUI. *See* Figs 10a & 10b (illustrating product selection summary with pricing information).

Likewise, a special purpose computer is also used to generate a unique identifier for the product. The product parameter identifying and pricing computer dynamically links the item parameters, the process parameters and the artwork parameters to dynamically generate a product identifier. This product identifier is unique to the parameters of that particular product, and is transmitted back to the user from the special-purpose computer to the GUI. *Id.* at Para.

[0051] (discussing applying a CG number to the product); Figs 12a & 12b (illustrating product process edit page wherein a CG number has been generated for the product and displayed over the GUI). For example, the product identifier can be based on the quoted price of the branded product. The SKU is generated at the same time the requested product is price quoted or ordered, making the price a mandatory factor in the product identifier. *See Id.* at Para. [0031] (emphasis added) ("A method and system of the present invention may create SKUs (or other identifiers) dynamically. For example, products may be separated into items and processes. Item parameters may be specified. Process parameters may also be specified separately. The item and process parameters may then be linked to create a SKU (or other identifier) when the product is sourced, *quoted*, ordered, or otherwise accessed."); *Id.* at Para. [0013] (emphasis added) ("Another object of the invention is to create SKUs (or other product identifiers) dynamically by separating products into items and processes (or other categories), specifying item parameters, specifying process parameters, dynamically linking an item and process and creating a SKU when the product is sourced, *quoted, or ordered.*"); *Id.* at Para. [0002] (emphasis added) ("Item parameters and process parameters may be separately specified and linked together to create a unique product where a product identifier (e.g., SKU) may be dynamically created when the product is sourced, *quoted, ordered* or otherwise accessed.").

The parent patent to the present application further shows that the present invention generates product identifier based, in part, on price. "The Stock Keeping Unit ("SKU") database may include vendor product, ***pricing***, service, and imprinting information. *See* U.S. Patent. No. 7,127,415 B1 (filed Nov. 16, 1999) (issued Oct.,24, 2006) col. 4 ll. 27-30 (emphasis added). *See also Id.* at col 4 ll 25-41 (emphasis added):

> The Stock Keeping Unit ("SKU") database 3010 may include vendor product, ***pricing,*** service, and imprinting information. A SKU is assigned to every vendor partner

product including variations within a product category. For example, a blue pen has a different SKU than a red pen. Vendors may enter product information in the SKU database at vendor entry point 3020.. Information entered may include general product information; imprinting information based on dynamic product entry; ***quantity breaks; net pricing per quantity***; ***net setup costs by imprint method,. . . net run charges per quantity based on imprint colors; a markup percentage added for each quantity to create their own retail pricing and other similar product information***.

By incorporating the foregoing as reference, the present invention clearly includes a product identifier that is generated based on a combination of the product's item, process, and artwork parameters **as well as price.**

Accordingly, Claims 1 – 5, 7, 8, 11 – 15, 17, and 18 recite statutory subject matter. Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

Claim Rejections - Rejection under 35 U.S.C. § 103

Claims 1 and 11 have been rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,493,677 to von Rosen ("Rosen") in view of Bittel, Lester Robert (Ed.), Encyclopedia of Professional Management, ISBN 0-07-005478-9, pp. 739 and 958 (1978) ("Bittel"). This rejection is respectfully traversed. The rejections against the pending claims under consideration should be withdrawn for at least the additional reasons set forth below. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Among other things, Rosen in view of Bittel fail to disclose all of the recited elements of independent claims 1 and 11.

Rosen in view of Bittel do not teach nor suggest a computer implemented method for configurating one or more products where products may be divided into items and processes, wherein item, process, artwork and price parameters may be separately specified and linked together to create a unique product where a product identifier may be dynamically created when the product is sourced, quoted, ordered or otherwise accessed (*see* Paragraph [0031]).

In contrast, independent claims 1 and 11 are directed to a computer implemented method and system for configuring one or more products where products may be divided into items and processes ***wherein item, process, artwork, and price parameters may be separately specified and linked together to dynamically create a unique product identifier when the product is sourced, quoted, ordered or otherwise accessed.*** Moreover, the independent claims teach ***storing product parameter data and a pricing algorithm on a data storage device such that the product parameter data is accessible by an online interface device on a network,*** and ***presenting a graphical user interface (GUI) for displaying representations of the product parameter data*** such that a ***user designates features of the product by selecting product parameter data represented by the GUI.*** Further, claims 1 and 11 recite that the product identifier ***is defined by a combination of the product's one or more item parameters, one or more process parameters, one or more artwork parameters, and price.*** These claimed features, among others, are completely missing in Rosen in view of Bittel.

The disclosure of von Rosen provides no discussion of product identifiers. Von Rosen is directed to creating and ordering customized branded merchandise but fails to provide any meaningful discussion of product identifiers that relates in any way to the claimed dynamic creation of a product identifier when the product is sourced, quoted, or ordered. Although Bittel does state that "one of the key materials management issues concerns itself ***with the problem of parts and materials standardization***," (Bittel at p. 739), Bittel does not teach nor suggest any solution to this problem, nor how to create a "good parts numbering system" in relation to customizable products. Bittel merely points out the problem—not the means for solving it. Neither von Rosen nor Bittel teach a product identifier ***defined by a combination of the product's one or more item parameters, one or more process parameters, one or more artwork***

parameters, and price, wherein item, process, artwork, and price parameters may be separately specified and linked together to dynamically create a unique product identifier when the product is sourced, quoted, ordered or otherwise accessed.

Claims 1 – 5, 7, 8, 11 – 15, 17, and 18 are Each Separately Patentable over Ferriter et. al.

The Examiner requested Applicant to address whether the current invention's product identifier generation step is disclosed in U.S. Patent No. 5,109,337 ("Ferriter"). Ferriter does not disclose a product identifier defined by a combination of the product's one or more item parameters, one or more process parameters, one or more artwork parameters, and price, wherein item, process, artwork, and price parameters may be separately specified and linked together to dynamically create a unique product identifier when the product is sourced, quoted, or ordered.

Ferriter discloses a project management system that uses a top down functional approach to hardware product design. The specification discloses the claimed system generating an item classification code "based on the gathered attributes, function, sourcing strategy and vendor" of a selected component of the larger item. *See* Ferriter, col. 5 ll. 53-63. "This item classification code can be used in many production planning functions, including scheduling and procurement." *Id.* at col. 5. 11. 63-65.

Ferriter does not teach nor suggest the present invention's product identifier generation system. First, the item classification code of Ferriter and the claimed product identifier of the present invention are defined by significantly different parameters.

Ferriter's item classification code is based on "the gathered attributes, function, sourcing strategy and vendor" of a *selected component* of a larger item. See *Id.* at col. 5 ll. 53-63. Ferriter's item classification code is not based on price nor is it based on artwork or item parameters. For example, in Fig. 4 of Ferriter, a user has selected an off-the-shelf battery for use

in a power unit component of a desired lawnmower. The item classification code of Ferriter is generated based on the contemplated usage of the battery *within the manufacturing process of the lawnmower*—not, for example, on the combination of the battery's item, process, artwork and the price parameters. In contrast, the product identifier of the present invention based on the combination of the item, process, artwork and price parameters of the requested item.

Second, unlike the product identifier of the present invention, the item classification code of Ferriter is not generated when the product is sourced, quoted, or ordered. Instead, the item classification code of Ferriter is generated when a user selects a type of subcomponent to be used in a component for a larger desired product. The *product*, at this point, is not yet sourced, quoted, ordered or otherwise accessed by the user. The example provided by Ferriter highlights this distinction. *See id.* at col.5 ll. 30-65 (describing the "battery" example); *see also* Fig. 4. Ferriter's item classification code is created when the user merely contemplates using the battery in the lawnmower. At this point, the lawnmower – the product – is not sourced, quoted, or ordered. This is logical, since Ferriter's invention embodies a product management simulator tool—not an actual, functioning ordering system that accesses vendor-supplied data. Further, because the present invention's product identifier is based at least in part on price, the product identifier is generated **at the time it is** quoted. The item classification code does not function in this manner as the price, unrelated to the code, merely appears along side the code displayed in Figure 4.

Third, one skilled in the art would not look to Ferriter's item classification code to perform same purpose as the product identifier of the present invention. Ferriter's item classification code is generated for a subcomponent of a larger product to be produced. For example, if the overall desired product is a lawnmower, the item classification code would be for

a component of the lawnmower such as the blade or the battery. *See Id.* at col. 4 ll.15-22. The code is used to classify the subcomponent so that the larger system, and the user, may make decisions regarding the overall production process of the larger product, such as scheduling and procurement. In contrast, the product of the present invention functions differently. The product identifier of the present invention is generated is for the *overall desired product* – indeed, it is defined by the combination of item, process, artwork, and price parameters – and it is used to identify the product *itself*. The product identifier of the present is not used for project scheduling like the item classification code of Ferriter.

Accordingly, claims 1 – 5, 7, 8, 11 – 15, 17, and 18 are each separately patentable over Ferriter et. al.

Conclusion

In view of the foregoing, Appellant respectfully requests that the Examiner withdraw the prior art rejections set forth in the Office Action and allow all of the pending claims.

Respectfully submitted,

GOODWIN PROCTER LLP

By: /Thomas J. Scott, Jr./
Thomas J. Scott, Jr.
Registration No. 27,836

Goodwin Procter, LLP
901 New York Avenue, NW
Washington, D.C. 20001
Telephone (202) 346-4000
Facsimile (202) 346-444

Dated: April 28, 2009